

REMARKS

I. Introduction

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

II. Status of the Claims and Summary of Amendments Thereto

By way of the foregoing amendments, claims 36-41 are cancelled. Pursuant to Applicants' election to prosecute the subject matter of Group I (*see* response dated October 20, 2003), the Examiner holds claims 26-41 as withdrawn from consideration. Consequently, claims 1-25 are now examined on the merits. Applicants reserve the right to pursue the cancelled subject matter in this application or by other appropriate procedural means.

The claims are amended to comport with the strictures of Group I as framed by the Examiner. *See* Office Action at page 2. Thus, variable "Ar", at each occurrence in the claims, no longer encompasses heterocyclic groups. Additionally, the definitions underlying permissible values for R₁, R₂, and R₃ have been amended to remove the possibility of these variables being heterocycles. Specifically, none of L, W, U, T, and Q is a heteroatom. These parameters account for other amendments to the claims. For example, the last proviso of claim 1, *inter alia*, is deleted, while certain species recited in claim 24 are deleted.

III. The Office Action

A. Rejection of Claims Under 35 U.S.C. §§ 102(b) or 103(a)

The sole issue at hand is the Examiner's allegation that claims 1-25 are anticipated, or in the alternative, are rendered obvious by U.S. patent No. 5,849, 732 to Suzuki et al. ("Suzuki"). Referring to disclosed compounds of formula (I), and to compound 47 in particular, the Examiner alleges, without explanation, that Suzuki "anticipate[s] . . . the instant compounds." Office Action at page 7.

Additionally, the Examiner advances the notion that Suzuki teaches a generic Markush of compounds "that fit within the scope of the generic claim." On this belief, the Examiner concludes that the person of ordinary skill would have made compounds within the

“scope of the teaching of Suzuki” and, thereby, would have been led to compounds that “fit within the scope” of the present claims. Applicants respectfully traverse this rejection.

B. Suzuki Does Not Anticipate

Suzuki does not teach any of the claimed subject matter because the prior-art and claimed compounds are structurally distinct from each other. “Anticipation under section 102 can be found only when the reference discloses exactly what is claimed . . .” *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775 at 780 (Fed. Cir. 1985). Here, the broadest claims require the presence of at least a three-carbon linker between the urea or thiourea moiety and substituent Z. This is so because the value of $l + n$ is at least 2. By contrast, none of the compounds disclosed by Suzuki shares this feature. For example, the corresponding fragment in disclosed compound 47 is a *diazo* moiety, i.e., $\text{-NH-NH-C}_6\text{H}_6$, which is not the claimed all-carbon linker. For at least this reason, Suzuki does not disclose every aspect of the claimed invention and, hence, does not anticipate, warranting withdrawal of this rejection.

C. Suzuki Does Not Render the Claims Obvious

A person of ordinary skill would not have considered the present invention to be obvious because the disclosed genus of compounds does not clearly overlap the claimed subject matter. Moreover, there is absolutely no suggestion in Suzuki that would have motivated the skilled person to make the claimed compounds.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference . . . Second, there must be a reasonable expectation of success. Finally, the prior art reference . . . must teach all of the claim limitations.

See MPEP § 2143.

As to the last criterion, discussed more fully above, Suzuki simply does not exemplify any compounds that fall within the scope of the claims. Nevertheless, the Examiner advances the sweeping notion that Suzuki “teaches a great number of compounds” that come within the scope of the present claims. Applicants understand the Examiner to suggest in this regard

that one of ordinary skill could pick and choose certain features of the disclosed “Markush of compounds . . . that [would have] fit within the scope of the generic claim.” Office Action at page 7. That a claimed species or subgenus is encompassed by a prior-art genus does not establish *prima facie* obviousness, however. See *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994)

Suzuki provides not even general guidance that would have led the person toward the claimed compounds. As noted above, none of the exemplified or preferred compounds that Suzuki discloses falls within the claimed genus. The Examiner urges in this regard that the disclosed compounds exhibit “pharmaceutical activity,” *id.*, a feature of the Suzuki compounds that allegedly engenders the requisite motivation. It stands to reason, however, that pharmaceutical activity, which is common to legions of unrelated compounds, would not have pointed the person of ordinary skill toward Applicants’ invention. For this reason, Suzuki evidences no motivation whatsoever for the skilled artisan to have made the claimed compounds.

The Examiner attemptst to bolster her position with the contention that “[m]aking further compounds that fit within the scope of [Suzuki’s] teaching is within the skill of the ordinary artisan.” Well-established principles of patent law, however, flatly refute such statements as grounds for establishing obviousness. See, e.g., *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000); and *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). Thus, the inquiry of whether or not a person of ordinary skill in the art would have been able to make the claimed compounds is wholly distinct from the pertinent question of whether that person would have been motivated to make those compounds. As Applicants propounded above, no such motivation exists.

Because Suzuki does not teach or suggest the claimed compounds, and because Suzuki does not evidence the motivation for the person of ordinary skill to have made the compounds, Applicants submit that the reference does not obviate the claimed invention. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the rejection.

IV. Conclusion

Applicants believe that the present application is now in condition for allowance and earnestly requests favorable notice of the same. If the Examiner feels that a telephone interview would advance the prosecution of the present application, she is invited to contact the undersigned by telephone.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.